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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/785,223

02/16/2001

Loren Swingle

Verizon-6

4340

32127

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12/16/2004

VERIZON CORPORATE SERVICES GROUP INC.

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EXAMINER

WEAVER, SCOTT LOUIS

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,223

Applicant(s)

SWINGLE ET AL.

Examiner

Scott L. Weaver

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-17, 24, 25 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-17, 24, 29-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2645

Response to Amendment

1. Applicant's arguments filed 8/6/2004 have been fully considered but they are not persuasive. Response to applicants remarks are provided below in **bold font** in the rejection(s) pertaining to that particular remark.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, (ln.2) "the generated audio file" lacks positive antecedent basis, use of consistent phrases will avoid confusion, 'generated' is believed to be intended as 'digital' as per previous references thereto.

In claim 3 (ln.6) "said system" lacks positive antecedence.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the receiving of email message with an audio file and a telephone number has no relation to any previous steps, nor does the initiating of a telephone call , further it is not clear if the audio file on the last line is related to the previous one or two audio files (ln. 7-8, ln. 9-10) and as to whether this monitoring and playing occurs in relation to any of the previous limitations, it is not even made clear as to what is being monitored

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 7 and 24, are rejected under 35 U.S.C. 102(e) as being anticipated by

Qua et al. (#6,222,909).

Qua teaches, (via figures 1, 3-4; col.3,ln.59-col.4,ln.3; col.5,ln.43-col.6,ln.10; col.6,ln.26-40; col.6,ln.46-col.7,ln.19) , method for operating communications device which includes accessing a voice message system (170 figure 1) and retrieving voice message (col.3, ln.61-67) over public switched telephone network (100, col.3,ln.1-7), a digital audio file [of the retrieved message] can be generated and attached to and email message which can then be forwarded to other service subscribers at any email address specified thus using an IP packet to send an email with attached audio file of the message to different service subscribers as pertains to claims 1-2. Qua teaches the user accessing the voice message system by calling and controlling the system via DTMF input as pertains to claim 3 (via col.7 as noted above) and the retrieval by the user ‘via any telephone communications device’ (via col.3,ln.61-62). With respect to claim 7, a use of the Qua system is enabled to receive email , manipulate email and compose email as known in the art of email and as such is enabled to forward an email received (col.6,ln.3-

Art Unit: 2645

6) with an attached audio file to various users, the content of emails is not excluded from including a telephone number therein and users of email are not excluded from calling telephone numbers seen in email messages.

With respect to the remarks of the response directed toward Qua and that Qua does not teach a voice message system with retrieval, the examiner can not allow claims 1 and 24 for this reason as the claims merely states a voice message is retrieved, voice message retrieval can be considered merely listening to a message, thus Qua clearly teaches a voice message is retrieved from the system which recorded it, Qua further states that voice messages can be downloaded from the system, absent this feature in claims 1 and 24 as presented , and uploaded for converting to text and forwarding (col.6,ln.26-58; abstract for example) via figure 3 which shows distribution via email. There is no attachment in claim 1 as per the remarks. With respect to attachment of an audio file as per claims 2 and 24, see figure 3, 310. With respect to the remarks directed toward downloading and then digitizing, this limitation is not in the claims, there is no limitation as to downloading or to where the digitizing of an audio file occurs. With respect to deletion after review, there are no limitations of such nature in the claims rejected by Qua.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 4, and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. (#6,222,909) in view of Baxter, Jr. (#6,385,306).

With respect to claim 4, Qua does not teach the user accessing the voice mail system by use of DTMF password input., nor the loading [and playing of] appropriate prompts according to script [schedule] attributed to the subscriber inputs as pertains to claim 9-13.

Baxter, Jr. teaches as is well known in the art of voice message systems the use of a caller identification input obtained from the caller by use of querying prompt (col.10, ln.6-12) and further teaches the use of the prompt generation for guiding the user through system menus which accept the user manipulation via DTMF key input .

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the voice message system of Qua to prompt for user identification as taught by Baxter, Jr. for the purpose of ensuring that the user was a valid paying subscriber and to further modify the system of Qua to use the appropriate prompting script as determined by user input as taught by Baxter, Jr. for the purpose of guiding the user through appropriate functions of

Art Unit: 2645

the system such as to determine when the system is waiting for an input to perform a next function.

In response to the remarks directed toward Qua and Baxter, Jr., there is no receiving of an email message indicating message received nor deletion required by any claims which are rejected by Qua in view of Baxter, Jr. The teaching is proper in that the features of using DTMF password are well known in any type of audio message system as are storing of prompts for presentation of such to users for enabling proper navigation with the audio system.

9. Claims 5, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. (#6,222,909) in view of Yaker (EP 0,893,902 A2).

With respect to claims 5 and 14, Qua teaches the method for controlling voice message system which enables the user to specify in the message sent for the recipient to respond to the message and as claimed provides that an email message is received indicating a voice message was reviewed.

Although Qua does teach enabling access to the voice message system for message manipulation, Qua does not teach the well known function of voice message systems of the user deleting the voice message (as pertains to claim 14 and 5), or accessing the system via telephone call and sending of control signal to delete as pertains to claim 15, nor that the telephone used is a voice message retrieval and forwarding device as pertains to claim 16.

Yaker teaches enabling a user to delete via use of DTMF signaling stored voice messages (abstract) so that the filling of the system with irrelevant messages can be avoided(col.3,ln.39-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Qua so that the voice messages could be deleted as necessary as taught by Yaker for the purpose of avoiding the filling of the system memory with irrelevant and outdated voice messages.

With respect to the remarks directed towards Qua in view of Yaker, Qua teaches providing additional instructions including ‘reply required’ to an email message sent, thus teaches receiving an email message indicating the audio message was received , Qua does not teach a user accessing the system for deletion of audio messages. Yaker does teach the deletion of audio messages is well known , this eliminates storage requirements in the system. The claims do not state the deletion is automatic and performed by the system itself, as written the claims do not exclude a user accessing the system and deleting messages which are no longer needed because they have been forwarded and such is obvious for the reasons stated above.

10. Claims 29-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qua et al. (#6,222,909) in view of Chau et al. (#5,751,792)

Qua teaches, (via figures 1, 3-4; col.3,ln.59-col.4,ln.3; col.5,ln.43-col.6,ln.10; col.6,ln.26-40; col.6,ln.46-col.7,ln.19) , method for operating communications device which includes accessing a voice message system (170 figure 1) and retrieving voice

message (col.3, ln.61-67) over public switched telephone network (100, col.3,ln.1-7), a digital audio file [of the retrieved message] can be generated and attached to and email message which can then be forwarded to other service subscribers at any email address specified thus using an IP packet to send an email with attached audio file of the message to different service subscribers as pertains to claims 29-31. Qua teaches the user accessing the voice message system by calling and controlling the system via DTMF input as pertains to claim 33-35 (via col.7 as noted above) and the retrieval by the user 'via any telephone communications device' (via col.3,ln.61-62).

Qua does not teach the use of plurality of voice message systems as per claim 29.

Chau teaches (col.1ln.35-54; col.4,ln.8-31; col.4,ln.48-56) use of plurality of voice message systems enabling user that is using a roaming device to receive voice messages when at a remote location to reduce costs to the subscriber (col.1,ln.27-32) as pertains to claims 29 and 32..

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of qua to include plurality of voice message systems as taught by Chau for the purpose of enabling a roaming subscriber of the Qua system to cost effectively manipulate voice messages as taught by Chau.

With respect to the remarks directed towards Qua in view of Chau, the claims rejected by Qua in view of Chau do not refer to deletion of voice messages as per the remarks (p.13) and as such the combination of the references to the claims above is obvious for the reasons stated above.

Art Unit: 2645

With respect to the combination of Qua with any of the secondary references alone, the combination would be obvious in view that figure 1 of Qua shows a voice mail system 170 and function of audio note taking system being to include all of such devices via (col.3,ln.8-21). Therefore the combination of known voice message systems as taught by any of the secondary references would be particularly relevant to one of ordinary skill in the art.


Conclusion

11. Claims 6 and 25 are allowed. The definite patentability of claim 8 can not be determined at this time due to the confusion noted above.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is 703-308-6974. The examiner can normally be reached on Tuesday to Friday 8 AM to 6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SCOTT L. WEAVER
PRIMARY EXAMINER
Art Unit 2645